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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/660,078	09/11/2000	John K. Smith	498-239	6232
23869	7590	04/20/2005		
HOFFMANN & BARON, LLP 6900 JERICHO TURNPIKE SYOSSET, NY 11791			EXAMINER RAGONESE, ANDREA M	
			ART UNIT 3743	PAPER NUMBER

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/660,078	SMITH, JOHN K.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Andrea M. Ragonese	3743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 13 January 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1 and 3-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 5-11 is/are allowed.
- 6) Claim(s) 1,3 and 4 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment filed on January 13, 2005 has been entered. Examiner acknowledges that **claims 1 and 5** have been amended. Subsequently, **claims 1 and 3-11** are under consideration.

### ***Response to Arguments***

2. Applicant's arguments, with respect to **claims 1, 3 and 4**, filed January 13, 2005, have been fully considered but they are not persuasive. Applicant's arguments center on the method of use of the apparatus, not the structure of the apparatus. These arguments are silent as to how the apparatus claims define the instant invention over the prior art of record. Applicant should note that new grounds of rejection are necessitated in view of Applicant's amendment of **claim 1**, incorporating a new claim limitation—"said patch comprising a tape configuration"—that has not been previously considered.

3. Applicant's arguments, with respect to **claims 1, 3 and 4**, filed January 13, 2005, have been fully considered and are persuasive. The rejections of **claims 5-11** have been withdrawn.

### ***Specification***

4. The use of the various trademarks has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks.

***Claim Rejections - 35 USC § 102 and 35 USC § 103***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. **Claims 1, 3 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as being obvious over Winston et al. (US 5,723,003).**

Regarding **claim 1**, Winston et al. discloses an endovascular prosthesis (generally at **10** and associated components), as shown in Figure 10, comprising:

- a. an endovascular member **10** (described as “outer graft” throughout the specification) having a tubular structure, as seen in Figure 10, comprising one of a hook structure and a loop structure (described as “attachment means” throughout the specification);

b. a patch **36** (described as "inner graft" throughout the specification) for placement against the endovascular member **10** "[in] order to hold the inner graft **36** in place on the assembly", the patch having the other of the hook structure and the loop structure (or "attachment means) which "is provided for attaching the inner tubular graft to the outer graft **10**";

wherein the hook structure and the loop structure are matingly engageable so as to maintain the patch **36** in substantially fluid tight engagement with the endovascular member **10** (column 7, lines 25-45), as shown in Figures 1-10; and

wherein said endovascular member **10** is selected from the group of grafts, stents and stent-grafts, as discussed throughout the specification.

Winston et al. discloses an apparatus comprising all the limitations recited in **claim 1** but does not explicitly recite that said patch **36** comprises a tape configuration. However, using a patch with attachment means, such as a hook and look structure, oriented in a tape configuration would be obvious, if not inherent, given the structure shown in Figure 10 and the prior art disclosure. Moreover, Applicant has not set forth any structural limitations (in the claims or in the specification) that would set the "tape configuration" of Winston et al. apart from that of the instant invention. As broadly and reasonably interpreted by the prior art drawings and specification, both the outer stent **10** (endovascular member) and the inner stent **36** (patch) with the attachment means have a "tape configuration" because as Winston et al. has stated, "the hook or loop material is secured in a conventional fashion," which is primarily a continuous strip of material with an adhesive backing, as known in the art as "tape."

Regarding **claim 3**, Winston et al. discloses that as applied to **claim 1**. Further, hook and loop structures that are of textile materials would be obvious if not inherent. Textile is an extraordinarily common material from which to construct hook and loop material.

Regarding **claim 4**, Winston et al. discloses that as applied to **claim 1**. Further, hook and loop structures that are selected from the group of polypropylene teraphthalate, polyurethane, a copolyester elastomer and nylon (see column 8), encompassed by Velcro®, would be obvious if not inherent to one with ordinary skill in the art as common hook and loop material.

***Allowable Subject Matter***

8. **Claims 5-11** are allowed.

***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Andrea M. Ragonese whose telephone number is 571-272-4804**. The examiner can normally be reached on Monday through Friday from 9:00 am until 5:00 pm.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A. Bennett can be reached on 571-272-4791. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AMR *AMR*  
April 17, 2005

Henry A. Bennett  
Supervisory Patent Examiner  
Art Unit 3743